

**REMARKS**

The Final Office Action of April 4, 2006, has been received and reviewed.

Claims 1-23 are currently pending and under consideration in the above-referenced application. Of these, claims 1-7, 9, 11, 12, and 14-23 have been rejected, while claims 8, 10, and 13 are directed to allowable subject matter.

Reconsideration of the above-referenced application is respectfully requested.

**Rejections under 35 U.S.C. § 103(a)**

Each claims 1-7, 9, 11, 12, and 14-23 stands rejected under 35 U.S.C. § 103(a).

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**Klun in View of Zimmer**

Claims 1-7, 9, 11 and 12 stand rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over that taught in U.S. Patent 5,667,541 to Klun et al. (hereinafter "Klun"), in view of teachings from U.S. Patent 6,054,183 to Zimmer et al. (hereinafter "Zimmer").

It is respectfully submitted that teachings from Klun and Zimmer cannot be relied upon to establish a *prima facie* case of obviousness against any of claims 1-7, 9, 11, or 12.

Specifically, it is respectfully submitted that Klun and Zimmer do not teach or suggest each and every element of any of claims 1-7, 9, 11, or 12.

Independent claim 1, as proposed to be amended herein, is directed to a method for fabricating a polishing pad conditioning apparatus that includes “selecting an abrasive material that is degradable or dissolvable by at least one chemical that does not substantially degrade or dissolve a material of a polishing pad to be conditioned . . .”

As noted by the Examiner, “the Klun reference teaches making an abrasive article out of quartz and, based upon the specification of the above-referenced application (paragraph [0030]), quartz is listed as an abrasive material that is degradable or dissolvable by at least one chemical that does not degrade or dissolve a material of the polishing pad.” Office Action, page 4. While Klun teaches use of quartz, Klun does not teach or suggest a method that includes the act of “selecting” quartz or any other abrasive material based on its “degradab[ility] or dissolvab[ility] by at least one chemical that does not substantially degrade or dissolve a material of a polishing pad to be conditioned . . .”

Klun does set forth various criteria for selecting an abrasive material: “[i]n choosing an appropriate abrasive particle, characteristics such as light absorption, hardness, compatibility with intended workpiece, particle size, reactivity with the workpiece, as well as heat conductivity may be considered.” Col. 18, lines 37-39. The characteristics of degradability and dissolvability with respect to a chemical or the degradability or dissolvability of the material of a polishing pad are not, however, mentioned as criteria in selecting the abrasive material.

Zimmer also lacks any teaching or suggestion of selecting an abrasive material based on its “degradab[ility] or dissolvab[ility] by at least one chemical that does not substantially degrade or dissolve a material of a polishing pad to be conditioned . . .”

Therefore, neither Klun nor Zimmer, taken separately or in combination, teaches or suggests the “selecting” element of independent claim 1.

Furthermore, as the active selection of an abrasive material based on its degradability or dissolvability is not taught or suggested by either Klun or Zimmer, it is not seen how one of ordinary skill in the art, without the benefit of hindsight that the claims of the above-referenced application provide to the Examiner, would have been motivated to combine the teachings of these references or had any reason to expect that the asserted combination of reference teachings would have been successful.

In view of the foregoing, it is apparent that a *prima facie* case of obviousness has not been established against amended independent claim 1. Therefore, it is respectfully submitted that, under 35 U.S.C. § 103(a), the subject matter recited to which amended independent claim 1 is directed is allowable over the teachings of Klun and Zimmer.

Each of claims 2-7, 9, 11, and 12 is allowable, among other reasons, for depending directly or indirectly from claim 1, which is allowable.

Claim 6 is further allowable because neither Klun nor Zimmer teaches or suggests a method that includes at least partially *impregnating a supporting substrate* with abrasive particles. Rather, the teachings of Klun are limited to coating a slurry of abrasive particles on a surface of a backing, (col. 12, lines 51-67; Col. 13, lines 1-6), while Zimmer merely teaches the uniform distribution of diamond particles *over* a substrate, with a subsequent layer of CVD diamond grown onto the exposed substrate (col. 4, lines 23-26; col. 5, lines 49-51).

Klun, Zimmer, and Bange

Claims 14-23 stand rejected under 35 U.S.C. § 103(a) for reciting subject matter which is allegedly unpatentable over teachings from Klun, Zimmer, and U.S. Patent 6,352,471 to Bange et al. (hereinafter “Bange”).

Each of claims 14-23 is allowable, among other reasons, for depending either directly or indirectly from claim 1, which is allowable.

Moreover, like Klun and Zimmer, Bange lacks any teaching or suggestion of a method that includes “selecting” an abrasive material “that is degradable or dissolvable by at least one chemical that does not substantially degrade or dissolve a material of a polishing pad to be conditioned . . .” Instead, the teachings of Bange are limited to “filaments including plastic abrasive particles, brush construction containing such abrasive filaments, methods of making such abrasive filaments, and methods of refining a workpiece using the brush construction.” Col. 2, lines 57-62. Therefore, Bange does not remedy any of the aforementioned deficiencies that preclude the use of teachings from Klun and Zimmer in establishing a *prima facie* case of obviousness against any of the claims of the above-referenced application.

Therefore, under 35 U.S.C. § 103(a), the subject matter recited in each of claims 14-23 is allowable over the subject matter taught in Klun and Zimmer.

Withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-7, 9, 11, 12, 14-23 is respectfully solicited, as is the allowance of each of these claims.

**Allowable Subject Matter**

The indication that claims 8, 10, and 13 recite allowable subject matter is noted with appreciation. None of these claims has been amended to independent form, however, as the claims from which they depend are believed to be allowable.

**Entry of Amendments**

Entry of the proposed amendment to independent claim 1 is respectfully requested. It is respectfully submitted that the proposed revision of independent claim 1 does not introduce new matter into the above-referenced application, particularly since the limitations that appear in independent claim 1 have already been considered and argued. Moreover, it is respectfully submitted that entry of the proposed amendment to independent claim 1 would not necessitate an additional search.

In the event that the proposed revision to independent claim 1 is not entered, entry thereof upon the filing of a Notice of Appeal in the above-referenced application is respectfully requested.

**CONCLUSION**

It is respectfully submitted that each of claims 1-23 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brick G. Power", written over a horizontal line.

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